

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

OPINIONS BELOW

The Opinion of the District Court (Tr. 146) was rendered July 11, 1942, and is reported in full in the opinion of the Circuit Court of Appeals.

The Opinion of the Court of Appeals for the Seventh Circuit (Tr. 273) was rendered April 30, 1943, and published 57 Pat. Q. 268; 135 F. (2d) 187.

JURISDICTION

1. The date of judgment to be reviewed is April 30, 1943.

2. The judgment was rendered in a Civil Action brought under the patent statutes to determine issues of validity and infringement of Letters Patent for invention.

3. The statute under which jurisdiction is invoked is 240a of the Judicial Code, 28 U.S.C.A. 347, as amended by the Act of February 13, 1925.

4. Cases believed to sustain the jurisdiction are:

Carbice Corp. vs. American Corp., 283 U.S. 27.
Morton Salt vs. Suppiger, 314 U.S. 488.

STATEMENT

For the facts generally, please see the Petition.

While the facts have been generally stated in the Petition, the Court may desire a more particular mechanical description of the jack of the patent in comparison with that accused as an infringement.

The hydraulic jack illustrated in the patent is of a type used to lift automobile and truck axles and wheels

while tire repairs are being made. Each jack is a small, self-contained unit, necessarily compact for convenient transportation and to enable it to be reached beneath the axle.

The fundamental parts of any hydraulic jack are a flat bottomed "base", a ram and ram cylinder extending vertically above the base, a reservoir for a supply of oil, a pump to draw oil from the reservoir and pass it under pressure to the base of the ram cylinder, whereby to force the ram upwardly and lift the load, and ducts for the passage of oil to and from the various parts of the jack, with check valves controlling oil flow from the reservoir to the ram cylinder, and a release valve by-passing the check valves to permit a reverse flow of oil from the ram cylinder to the reservoir for lowering the ram.

Leakage was a serious problem in prior art jacks. Some of the intercommunicating passages of a jack are subject to the high pressure of the pump and ram cylinder, whereas other passages are subject only to the low pressure of the reservoir. Prior art jack constructions were such that the high pressure passages had to be bored into the jack from the outside and thereafter externally closed by screw plugs, at which leakage occurred. One of the objects of the present invention is to reduce the number of places where high pressure leakage can occur externally around such plugs.

Another problem in the art was to accommodate the various parts upon a base of standard size. In the prior art jacks, the ram and its cylinder had to be located too near one end of the base in order to make room for the pump at the other end, thus positioning the load eccentrically of the supporting surface and tending to permit the jack to tip easily under load. The present jack

solves that problem by its novel disposition of the pump and permits the ram and its cylinder to be nearly centered on the base.

Another problem of the prior art jacks was excessive height. Although there is a very limited clearance available beneath an automobile axle, the range of lift required is great. Insofar as prior art constructions require the location of ducts beneath the ram, an undue height of the collapsed jack was inevitable and it became difficult to manipulate the jack beneath the axle of a car having a deflated tire. The particular organization to which the claim in suit is directed solves this problem and permits of an unusual degree of ram extension in proportion to the overall height of the collapsed jack.

In solving all of the several problems above described, an outstanding feature of the Plaintiff's invention is the novel characteristic of the oblique angular position of the pump in which it is disposed intermediate the ram and the release duct.

Referring to the drawing of the patent in suit (Tr. 158), the ram cylinder is shown at 12. The ram, which moves like a piston vertically in the cylinder, is designated by reference character 10. The reservoir 14 for low pressure oil surrounds the ram cylinder and is formed by a sleeve 13 spaced from the cylinder.

The release duct 38, closed at its outer end by a needle valve 40, 41, is not quite horizontal.

The pump chamber 25 is located at an angle almost bisecting the angle between the vertical ram cylinder 12 and the release duct 38. Operating in the pump chamber is the pump plunger 26, reciprocated by handle

56. As the pump plunger moves upwardly in the chamber, it draws oil from reservoir 14 through duct 30 past the check valve 45. As the plunger 26 moves downwardly in the pump chamber 25, it forces check valve 45 to its seat and the oil escapes through check valve 36 into duct 37, which communicates with the release duct 38, leading to the ram cylinder. Pressure of oil thus forced into the bottom of the ram cylinder acts on the ram to raise it and its load.

When the needle valve 40, 41 is retracted from its seat, the oil in the ram cylinder by-passes the check valves and the pump and is permitted to flow through duct 42, 43, 33 back to the duct 30 and thence back to the reservoir. This allows the load on the ram to lower the ram in the cylinder 12. As long as the needle valve 41 remains seated the check valves will prevent any return flow of the oil and will hold the load on the ram in its elevated position.

As shown in the patent, the organization is such that all ducts which in any manner penetrate to the outside of the jack are low pressure ducts. If any oil whatever leaks from a high pressure duct it will be intercepted by a low pressure duct which will return it to the reservoir.

The position of the pump chamber intermediate the ram cylinder 12 and the release duct 38 at the oblique angle in which it is illustrated in Figure 1, is the primary feature, which, in the combination set forth in claim 6, permits the concentration of the various ducts to reduce the number of high pressure plugs previously required, and, at the same time, to enable the jack to be very compact when the ram is retracted in proportion to the unusual amount of ram extension which is possible.

The Respondent's accused construction is illustrated, while at the same time claim 6 in suit is applied, element by element thereto, as follows:

(The drawing is a reproduction of Defendant's Ex. K, to which Petitioner has applied reference characters identified with the claim elements as recited below).

CLAIM 6

A hydraulic jack comprising the combination with—

A—an upright cylinder, and

B—a concentric reservoir, of

C—a base with which said cylinder and reservoir are in liquid tight relation

D—a ram operative in said cylinder

E—a duct in said base leading directly from the bottom of said cylinder to an exterior side surface of the base, and

F—provided at an intermediate point with a valve seat shoulder.

G—a bleed valve threaded in said duct for axial adjustment therein to and from said shoulder

H—a pump chamber formed in said base and opening therefrom along an axis inclined with reference to said cylinder and intermediate said cylinder and said duct

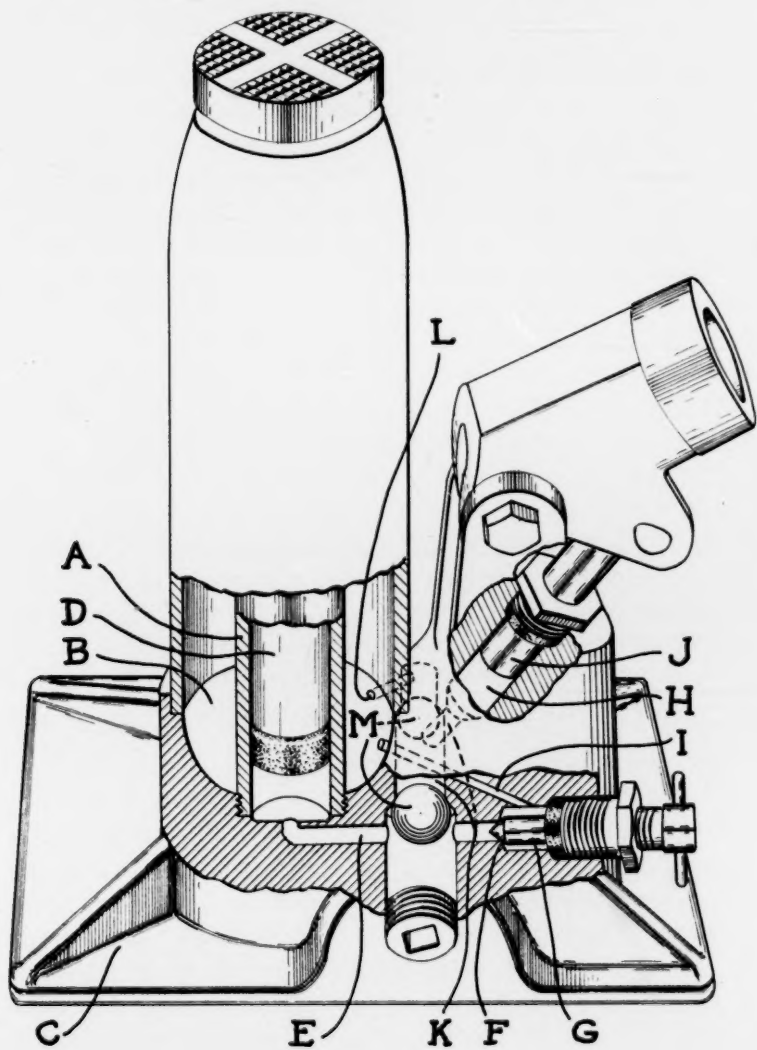
I—a by pass duct leading from said first mentioned duct externally of said shoulder to said reservoir

J—a pump plunger operative in said chamber

K—a high pressure duct extending from the chamber to the first mentioned duct

L—and a supply duct in communication with the reservoir and leading to the high pressure duct

CLAIM 6 AS APPLIED TO DEFENDANT'S JACK





M—and check valves at the junction of the supply duct with the high pressure duct whereby to control liquid urged by the plunger from said reservoir to the cylinder.

As can be seen from the above cut, Respondent's ram cylinder A and his release duct E are in a common vertical plane from which his pump chamber H is slightly offset laterally. Due to the lateral offset, Respondent does not concentrate the ducts of its jack quite as effectively as is suggested by the Patent in suit. Consequently, Respondent uses as part of his duct system a transverse connecting duct to which the lead line from reference character K extends in the cut and which requires a single high pressure plug at one of its ends. However, notwithstanding the offset, the intermediate location of the pump chamber in the accused jack construction shown in the cut enables Respondent to reduce the number of high pressure plugs to a single plug (in contrast with three to seven high pressure plugs which it had found necessary in previous jack constructions). In addition, the Respondent's use of the intermediate position of the pump chamber has enabled Respondent to bring its ram cylinder closer to the center of the base without increasing the height of the jack when the ram is retracted.

The oblique angular location of the pump chamber, whereby it is located intermediate the ram cylinder and the release duct, is completely new in the combination claimed. It has consistently been Petitioner's position that no reference or combination of references shows or suggests the invention in suit. The Respondent's expert witness has not made any contention to the contrary. Respondent has not, in the Courts below, show any prior art anticipating or limiting the claims in suit.

SPECIFICATION OF ERRORS

The errors which Petitioner will urge if the Petition for Certiorari is granted, are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. In holding claim 6 not infringed by Respondent's accused construction.

2. By importing into claim 6 in suit a dispensable limitation not recited in the claim, and thereby enabling Respondent to escape the consequences of its appropriation of the invention.

3. In interpreting claim 6 in suit in a manner contrary to the normal and natural meaning of its language.

4. In assigning to claim 6 in suit a narrower interpretation than that to which it is entitled on its face, in the complete absence of any prior art requiring such restricted interpretation.

5. In requiring complete achievement of all possible advantages of the patent as a test of infringement instead of applying the language of claim 6 of the patent in suit.

6. In finding non-infringement because Respondent imperfectly practices the invention of claim 6 of the patent in suit to obtain only the majority of its benefits without obtaining all of them fully.

SUMMARY OF ARGUMENT

1. Accepting claim 6 of the patent in suit at its face value, the claim is infringed.

2. The prior art affords no basis for accepting claim 6 of the patent in suit at less than its face value.

3. The patent in suit is an important patent, licensed to one large jack manufacturer, extensively infringed by Respondent, and respected by two other substantial jack manufacturers who imitated the construction when it appeared on the market but discontinued their infringement upon notice.

4. A claim should not be narrowed by importing into it, by construction, any dispensable element in order to enable an infringer to escape the consequences of his infringement.

5. One should not escape infringement by practicing the invention imperfectly.

6. The equities favor your Petitioner.

7. The question as to the extent to which, if at all, limitations not requisite to validity or to eliminate ambiguity may be imported into a patent claim by Court interpretation is an important question upon which this Court has not passed.

ARGUMENT

Point I. Claim 6 is Infringed.

Infringement may be either a question of fact or a question of law, depending on the particular point raised.

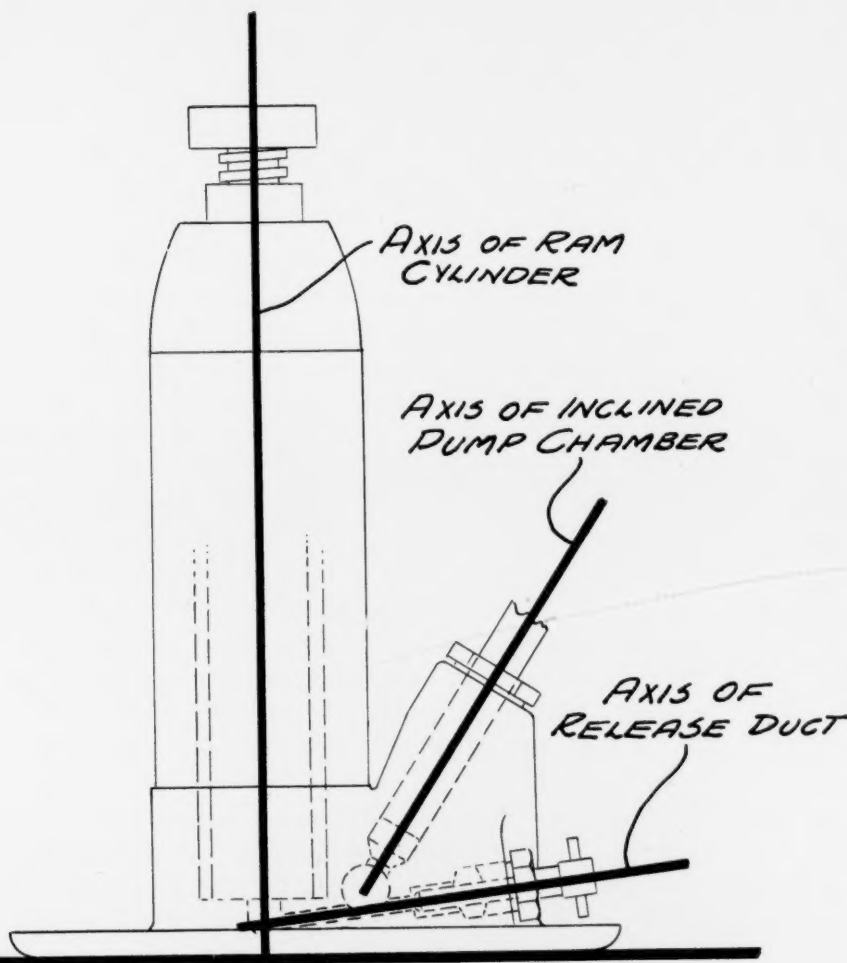
In the present case the Lower Court's finding of non-infringement is based upon its concept of the law. There can be no question, as shown above in the Statement of facts, that the language of claim 6 is applicable verbatim to Respondent's accused jack. It has been applied to the jack.

Respondent, however, contends that because its pump chamber is offset from the plane of the ram cylinder and the relief port, it is not intermediate.

The claim is not so limited. We have here a very important invention which has had a notable impact upon the art. To say the least, therefore, the claim is entitled to the broadest interpretation which its language will bear in the light of the art. The art will be discussed later. Assuming for the moment that a broad interpretation is permissible, what, then, is the normal and natural meaning of the word "intermediate"?

If a traveler uses train service from Milwaukee to St. Louis, Chicago is intermediate Milwaukee and St. Louis. The train will necessarily pass through Chicago. It is true that a perfectly straight line drawn from Milwaukee to St. Louis will not pass through Chicago, but by all means of travel and by all normal human experience Chicago is in fact intermediate Milwaukee and St. Louis. So, in terms of geographical location and in terms of function of the pump in a hydraulic jack, Respondent's pump chamber is intermediate the release duct and the axis of the ram cylinder. Inspection of Respondent's jack in side elevation will show that the pump axis virtually bisects the angle formed between the release duct and the ram axis in exactly the same manner and to exactly the same extent as in the patent. (See the annexed diagram).

In a hydraulic jack the intermediacy of the pump in an inclined position between the release duct and the ram, signifies that it is *intermediate*, not only geographically but functionally, in terms of pumping fluid between these parts, and from the reservoir which is concentric with the ram cylinder and has the same axis.



Such intermediacy is not avoided by offsetting the pump laterally while preserving the general relationship which enables Respondent to achieve most, if not all, of the advantages of the patent. After all, the offset of Respondent's pump chamber is but a fraction of an inch, and, considering the significance of the invention, it is indeed a poor rule of law which would enable a copyist to escape responsibility for his piracy merely because of so slight a change.

Point II. The Prior Art.

The claim language was not chosen to distinguish from the prior art. No art is cited of record which approaches the subject of the claim in any way to require a limited interpretation of the word "intermediate". On the contrary, the word "intermediate" was used in the claim merely to indicate the general position of the inclined pump chamber which enabled Petitioner in the patent, and Respondent in the accused jack, to concentrate in each instance the ducts leading to and from the reservoir, the pump, and the ram cylinder.

In view of the proceedings below and the failure of the Trial Court or the Court of Appeals to discuss the prior art, and the failure of Respondent to point out any prior art which requires the limitation asserted for the claim in the Court of Appeals, it is probably needless for Petitioner to discuss the prior art in detail. The patents which show inclined pump chambers include No. 24,759, July 12, 1859 (Tr. 170), and No. 569,574, October 13, 1896 (Tr. 176). In neither of these patents is the inclined pump so located that it can possibly be said to be intermediate in any sense, and in neither of these patents is there anything approaching the combina-

tion to which claim 6 in suit is directed. The most recent of these patents is 47 years old. If any of them had taught the art the intermediate position of a pump chamber in a jack combination as claimed, the art would long since have adopted this construction.

Point III. The Importance of the Patent.

The fact that four large jack manufacturers, including Respondent, and Petitioner's Licensee, and the two which discontinued infringement upon notice, all adopted this construction immediately after Petitioner invented it, is cogent evidence of the importance and merit of the invention and the complete lack of any suggestion thereof in the prior art.

Point IV. A Claim Should Not be Narrowed by Judicial Construction.

In the case of *Cincinnati Cadillac Co. vs. English Mersick Co.*, 18 Fed. (2) 542, Judge Moorman wrote an opinion for the Sixth Circuit Court of Appeals, in which he said:

"It is manifestly true that the courts are without power to enlarge or restrict a claim, for the purpose of making out a case of validity or infringement." (citing cases).

The court proceeds to state that a claim may be construed either in the light of its specification or the prior art "not for the purpose of expanding or limiting it, but for the purpose of making it operative or ascertaining its true meaning". In this connection the court cites its own decision in the case of *Crown Cork & Seal Co. vs. Sterling Cork & Seal Co.*, 217 Fed. 381, and also

cites *Westinghouse vs. Boyden*, 170 U. S. 537, both of which are leading cases on this issue.

In the Cincinnati Cadillac case the issue was one of validity, infringement being admitted. In the present case so little point has been made of any issue of validity that validity is apparently conceded, and the prior art, as above noted, wholly fails to impose any limitation on a claim which on this record must be accepted as valid. Yet the court has taken this claim, which, in any ordinary meaning of the language used would require a finding of infringement, and has distorted one of the words in the claim out of its normal and usual meaning in such a way as to add to the claim a limitation not expressed therein.

Not only does the claim contain no limitation requiring the pump chamber to be in the same plane as the ram cylinder and the release duct, but, as noted in the Petition, claims containing this limitation were considered by the Patent Office and were cancelled. The cancellation of all claims referring to any co-planar relationship between these parts gives added effect to the intent of the Patentee and the Patent Office to allow a claim which does not contain this limitation.

In the case of *Morgan Envelope Co. vs. Albany Paper Co.*, 152 U. S. 425, 429, this court held that where a change made in the Patent Office was a broadening one, it could not be construed away even to save the validity of the patent. How much less should it be permitted to be construed away where the effect of the change is to hold an obvious infringer?

Walker on Patents, Dellers Edition, Volume 2, page 1207, says:

"On the other hand, a claim will not be narrowed by importing into it, by construction, any dispensable element, in order to enable an infringer to escape the consequences of his infringement."

In *McClain vs. Ortmyer*, 141 U.S. 419, 425, this court said:

"In a case of doubt, where the claim is fairly susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention."

In *Topliff vs. Topliff*, 145 U.S. 156, 171, this court said:

"The object of the patent law is to secure to inventors, a monopoly of what they have actually invented or discovered and it ought not to be defeated by too strict a technical adherence to the letter of a statute or by the application of artificial rules of interpretation."

What could be more artificial than the interpretation given the word "intermediate" in the court below?

Point V. Imperfect Infringement is Still Infringement.

As opposed to the conclusion of the court below that Respondent escapes infringement because he still has to use one high pressure plug, the fact is that the claim in suit contains no reference whatever to the presence or absence of any plug. The court has, in effect, substituted a test for infringement based on results for one based on the language of the claim. It is almost too fundamental to require mention here that the scope of a patent is determined by its claims. This is statutory. (R.S. 4888, *U. S. Code, Title 35, Section 33*).

In *Continental Paper Bag Co. vs. Eastern Paper Bag Co.*, 210 U.S. 405, 419, this court said:

"The claims measure the invention".

That the claim in suit reads verbatim upon the accused jack has been demonstrated. Yet the Court of Appeals, in the short paragraph considering the issue of infringement, refers first of all to the fact that the ducts in Respondent's device are not in the same plane (the claim does not require that they be in the same plane). The Court of Appeals then refers to the cross drilling of Respondent's jack (the claim does not exclude the possibility of cross drilling). The Court of Appeals then refers to the cross drilling being plugged at its outer end, thus requiring a high pressure seal at this point (The claim does not exclude a construction employing a high pressure seal and does not refer at all to the presence or absence of a plug.

Where it so clearly appears that the essence of the claimed invention is the intermediate location of an inclined pump chamber between the ram cylinder and the release duct in a general combination which permits of the concentration of the ducts at the lower end of the pump chamber, and when it appears that Respondent has this arrangement and has accomplished this concentration, and thereby has achieved many of the objectives of the patent in suit, why should he be released from responsibility from his infringement merely because he has not achieved them all?

In *Auditorium Corp. vs. Greater Rochester Properties*, 59 F. (2), 450, the court said:

"Nor is impairment of a function, or even a mere mechanical improvement or new coordination of parts without achieving a new result, an excuse for

appropriation of a prior invention covering the same idea of means. Whatever changes have been made in defendant's adaptations are simply colorable without any new system of operation."

In the case of *Kansas City Southern Railway vs. Silica Products Co.*, 48 F. (2) 503, the court said:

"If in some slight particular there has been a variance and the result has been a product of the patent, this will not avoid infringement 'one does not escape infringement by practicing the invention imperfectly'." (Citing cases).

In the U. S. District Court for the Eastern District of New York in the case of *Syracuse Chilled Plow Co. vs. LeRoy*, 233 Fed. 682, the Court said:

"It makes no difference that Defendant does not adapt its construction to attain all the benefits of the patent in suit."

Point VI. The Equities Favor Petitioner.

Petitioner cannot overlook the fact that whatever Respondent knows about the accused jack is based upon Petitioner's own disclosure of his invention to Respondent long before his patent issued.

Respondent had copied that invention and had the accused jack on the market before Petitioner had his patent. The facts in this regard have not been traversed on the record.

Point VII. The Important Issue of Interpretation Here Raised Requires Adjudication in This Court.

In the leading case of *Westinghouse vs. Boyden*, 170 U.S. 537, this court laid down some broad rules of claim interpretation requiring in general that the lower courts

give to patent claims such scope as the nature of the invention warrants. Insofar as the mandate of the Westinghouse case is applicable here, the decision of the Court of Appeals is in derogation thereof. It has been shown above that the art does not impose upon the claim in suit any such limitation as has been ascribed to that claim by the Court of Appeals. It has been shown above that the interpretation ascribed to the claim by the Court of Appeals is a strained interpretation, repugnant to the natural meaning of the words.

It is believed that this Court has never passed upon the precise question here involved as to whether it is not arbitrary for a court to allow an infringer to escape the consequences of his acts merely because he imperfectly practices the invention as a result of offsetting a part for less than an inch from the position which it would have if all of the objectives of the patent were fully to be obtained.

Where the claim language applies to the accused construction, and infringement would therefor seem to follow logically under the statute, does the infringer nevertheless have to have *all* the objectives of the patent, as well as the claimed structure, before he can be held responsible? This is a question which it is believed that this Court has never decided, and is one of importance as indicated not only by the present case, but by the decisions in the cases cited supra, *Auditorium Corp. vs. Greater Rochester Properties*, 59 F. (2) 450, (W. D. New York); *Syracuse Chilled Plow Co. vs. Leroy Plow Co.*, 233 Fed 682, (W. D. New York); and *Kansas City Southern Railway Co. vs. Silica Products Co.*, 48 F. (2), 503, (C.C.A. 8th), as well as the decision in *Cincinnati Cadillac Co. vs. English Mersick Co.*, 18 F. (2), 542, (C.C.A. 6th).

CONCLUSION

Wherefore Petitioner earnestly prays that a writ of certiorari be granted; the case be reviewed; and the Decree of the Court of Appeals for the Seventh Circuit finding non-infringement of Werner patent No. 2,038,974 be reversed.

Respectfully submitted,

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July 28, 1943.